

2. REMARKS / DISCUSSION OF ISSUES

Claims 1-9 and 11-40 are pending in the application. Claims 6, 8, 9 and 12-14 are withdrawn from consideration at this time.

Rejections under 35 U.S.C. §112, ¶2

Claims 2-5, 7, 10, 11, 15-19 and 36-38 were rejected under 35 U.S.C. §112, ¶2 as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter that Applicants regard as the subject matter of the invention. For at least the reasons set forth below, Applicants respectfully submit that this rejection is improper and should be withdrawn.

The second paragraph of § 112 requires the specification of a patent to "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."¹ To satisfy this requirement, the claim, read in light of the specification, must apprise those skilled in the art of the scope of the claim.² Moreover, claims need not "be plain on their face in order to avoid condemnation for indefiniteness; rather, that the claims be amenable to construction, however difficult that task may be." The requirement to "distinctly" claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles.³ Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.⁴

Applicants respectfully submit that claims 2-5, 7, 10, 11, 15-19 and 36-38 are not only not insolubly ambiguous but also are facially definite. Applicants have been given no specific reason why any of the claims are allegedly indefinite, but rather the Office Action merely states that they are. Applicants have reviewed claims 2-5, 7, 10, 11, 15-19

¹ 35 U.S.C. § 112, P2 (2000).

² See *Miles Lab. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993).

³ *Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1547 (Fed. Cir. 1984).

⁴ *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

and 36-38, and have failed to uncover issues of lacking antecedent basis or ambiguity that would warrant a rejection under 35 U.S.C. §112, ¶2. Applicants further submit that the failure of the Office Action to present clear explanation of why the claims are rejected under 35 U.S.C. §112, ¶2 improperly shifts the burden of proof from to Applicants, resulting in the failure to establish a *prima facie* case of indefiniteness, and therefore a failure to establish a proper rejection under 35 U.S.C. §112, ¶2.

In the rejection of claims 2-5, 7, 10, 11, 15-19 and 36-38, the Office Action relies upon a different paragraph of 35 U.S.C. §112, in an effort to establish indefiniteness. Applicants respectfully submit that it is improper to turn to 35 U.S.C. §112, ¶4 as a basis for a rejection under 35 U.S.C. §112, ¶2, as 35 U.S.C. §112, ¶4 requires further specificity of dependent claims, but does not relate to indefiniteness. Applicants therefore respectfully request clarification as to this issue, should any rejection under 35 U.S.C. §112 be maintained in future official correspondence.

Applicants note that the Office Action asserts:

“However, the additional limitation[s] appear to be tangential to the subject matter set forth in claim 1, from which claims 2-5, 7, 10, 11, 15-19 and 36-38 ultimately depend, such that it cannot be determined what additional steps or acts are required in addition to those already recited in claim 1.”

No support for the position presented in the Office Action for the assertion that claims 2-5, 7, 10, 11, 15-19 and 36-38 fail to comply with 35 U.S.C. §112, ¶4. Rather, a conclusory statement that claims 2-5, 7, 10, 11, 15-19 and 36-38 fail to comply with 35 U.S.C. §112, ¶4. Applicants respectfully submit that the Office Action fails, therefore, to comply with MPEP § 706, which states, in part:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity (emphasis added).

Plainly, rather than a clearly articulated rejection, the rejections under 35 U.S.C. §112, ¶2, 4 fail to present any basis in support of the rejections. Applicants respectfully submit that the rejection is improper for at least this reason. Applicants further submit that any further rejection under 35 U.S.C. §112, ¶4 cannot be made properly final.

Finally, in the interest of completeness, Applicants direct attention for example, to claim 2, which depends from claim 1, and respectfully submit that this claim is compliant with 35 U.S.C. §112, ¶4. Notably, claim 2, recites:

*A method as claimed in claim 1, wherein **said changing** takes place before said introducing, or **said introducing** and **said changing** are carried out essentially at the same time, and/or **said changing**, **said detecting** and **said evaluating** are repeated at least once.*

So, each emphasized feature of claim 2, further defines steps set forth in claim 1. These further steps are not only not tangential from the features of claim 1, but also directly further specify each step of changing, introducing, detecting and evaluating set forth in claim 1.

For at least the reasons set forth above, Applicants respectfully submit that the rejections under 35 U.S.C. §112 are improper and should be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-5, 7-11, 15-19 and 36-40 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Collin, et al.* (Nucleic Acids Research (2000) in light of *Evans* (Biomolecular NMR Spectroscopy) and *Piotti, et al.* (Journal of Biomolecular NMR 1992).

A proper rejection of a claim under 35 U.S.C. § 102 requires that *a single prior art reference disclose each element of the claim.*⁵ Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.⁶ Alternatively, anticipation requires that each and every element of the claimed invention

⁵ See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

⁶ See, e.g., *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

be embodied in a single prior art device or practice.⁷ For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.⁸

Claim 1 recites:

A method for the spatially resolved determination of physical, chemical and/or biological properties or state variables, particularly substance concentrations, temperature, pH and/or physical fields, and/or the change in such physical, chemical and/or biological properties or state variables in an examination area of an examination object by determining a change in spatial distribution and/or mobility of magnetic particles in the examination area or in parts thereof as a function of the effect of physical, chemical and/or biological influencing variables on at least a part-area and/or in the physical, chemical and/or biological conditions in at least a part-area of the examination area, the method comprising:

a) introducing coated magnetic particles having a coating into at least part of the examination area,

*b) **generating a magnetic field with a spatial profile of the magnetic field strength such that there is produced in the examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength,***

c) changing the relative spatial position of the first and second part-areas in the examination area or changing the magnetic field strength in the first part-area so that the magnetization of the particles is locally changed,

d) detecting signals that depend on magnetization in the examination area that is influenced by said changing, and

*e) **evaluating the signals so as to obtain information about change in the spatial distribution and/or mobility of the magnetic particles in the examination area,***

⁷ See, e.g., *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). (Emphasis added.)

⁸ See, e.g., *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

wherein the coating is degradable and inhibits mobility of the particles.

Claims 39 and 40 include features similar to those of claim 1 discussed presently.

In three paragraphs on pages 4-6, the Office Action attempts to summarize all pending claims in a single paragraph. At the outset, Applicants respectfully submit that the subject matter of the pending claims is controlling of the metes and bounds of the invention, and is not limited by the summary of the subject matter provided in the reproduced portion of the Office Action.

Moreover, Applicants respectfully submit that the rejection fails to clearly consider all features of twenty pending claims. For example, the Office Action fails to present any evidence in support of the rejection of the emphasized features of claim 1 presented above. Applicants respectfully submit that the Office Action fails to comply with MPEP § 706. Because Applicants have been deprived of the opportunity to consider all substantive aspects of the rejection, Applicants respectfully submit that any future rejection cannot be properly made final.

The Office Action is also improper for rejecting claims 1-5, 7-11, 15-19 and 36-40 for anticipation based upon not a single reference, but three references. As noted above, a *prima facie* case of anticipation requires that all elements of a claim be disclosed in a single prior art reference.

The Office Action asserts:

“Collin teaches the application of NMR experiments applied to samples of isotopically labeled DNA and RNA at 1mM concentrations recorded on a Bruker DRX-600 spectrometer and a Bruker DRX-800 spectrometer with triple resonance, three-axis gradient probes. See Collin et al. page 3386, col. 2, line 35 through page 2287, col. 1, line 5.”

While the Office Action fails to specify the features of claim 1 that are allegedly anticipated by this portion of the Office Action, Applicants respectfully submit that there is no disclosure in *Collin, et al.* for “*generating a magnetic field with a spatial profile of the magnetic field strength such that there is produced in the examination area a first part-area having a low magnetic field strength and a second part-area having a higher*

magnetic field strength.” As such, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 1, and therefore, a *prima facie* case of anticipation has not been established. Accordingly, claim 1 is patentable over the applied art. Furthermore, and for substantively identical reasons, Applicants respectfully submit that claims 39 and 40 are patentable over the applied art. Finally, claims 2-5, 7-11, 15-19 and 36-38, which depend immediately or ultimately from claim 1, are patentable for at least the same reasons and in view of their additionally recited features.

Finally, the Office Action asserts that “dependent claims comprise the recitation of inherent sample properties and inherent features of NMR spectroscopic investigation.” (See page 4 of the Office Action.)

Applicants respectfully submit that not only does the Office Action fail to specify which features of the dependent claims are allegedly inherent, but also inherency has not been established. M.P.E.P. § 2112 IV provides that:

*EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING
TO SHOW INHERENCY*

*The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “**To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference,** and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” In*

re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

(emphasis added).

Furthermore, a claim rejection must be based on objective evidence of record, and cannot be supported merely on subjective belief and unknown authority. See, e.g., M.P.E.P. § 2144.03; *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *In re Zerko*, 258 F.3d at 1386, 59 USPQ2d at 1697.

No such concrete evidence has been provided by the Examiner here, nor did the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see M.P.E.P. § 2144.03). Applicants respectfully request that such an affidavit be provided if a rejection continues to be made without a citation of any objective evidence.

For at least the reasons set forth above, Applicants respectfully submit that a prima facie case of anticipation has not been established and therefore, all pending claims are patentable over the applied art.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos/

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